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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,896	04/05/2001	Joseph P. Steiner	23105-B	4483

29728 7590 12/31/2002

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EXAMINER
COOK, REBECCA

ART UNIT	PAPER NUMBER
1614	16

DATE MAILED: 12/31/2002

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 16

Application Number: 09/825,896
Filing Date: April 05, 2001
Appellant(s): STEINER ET AL.

Sean Passion
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 21, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 25-27 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 25-27 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 22-24 of prior U.S. Patent No. 6,239,164. This is a double patenting rejection.

If the instant application were to issue as a patent there would be an extension of monopoly on the 6,239,164.

(11) Response to Argument

Appellants argue that the inventions are nonidentical because the present claims embrace more embodiments than the claims of '164. That is, a relevant part of present claim 25 recites "an effective amount of a compound of formula I." However, a relevant part of the '164 patent's claim 21, from which claims 22-24 depend, recite "an effective amount of a non-immunosuppressive pyrrolidine or pyrrolidine amide compound having an affinity for FKBP-type immunophilins." Appellants further argue that embodiments that are excluded from '164's claims 22-24 but not present in the present application's claims 25-27 are believed apparent from the broadest reasonable interpretation of these claims. This is not persuasive, since the claims are read in light of the specification and

on page 4, lines 20-25 the specification discloses that the instant compound has an affinity for FKBP-type immunophilins and that a key feature is that it does not exert any significant immunosuppressive activity in addition to its hair growth activity. IN view of this disclosure it is inherent that the instant compound is non-immunosuppresive and has an affinity for FKBP-type immunophilins.

Furthermore, if the instant application were to issue as a patent there would be an extension of monopoly on 6,239,164.

For the above reasons, it is believed that the rejections should be sustained.

DWAYNE C. JONES
PRIMARY EXAMINER

Respectfully submitted,
Rebecca Cook
Primary Examiner
Art Unit 1614

RC
December 30, 2002

Conferees

JEROME D. GOLDBERG
PRIMARY EXAMINER

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